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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/183,791 10/30/98 JACOVES

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EXAMINER

KAZIMI, H

ART UNIT

PAPER NUMBER

2165

DATE MAILED:

02/27/01

THOMAS R. FELGER, ESQ.
BAKER BOTTS LLP
2001 ROSS AVENUE
DALLAS TX 75201

TM02/0227

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/183,791

Applicant(s)

Jacoves et al.

Examiner

Hani Kazimi

Group Art Unit
2165



☒ Responsive to communication(s) filed on Dec 11, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-57

Of the above, claim(s) _____ is/are pending in the application.

☐ Claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 1-57 is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claims _____ is/are objected to.

_____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. This communication is in response to the amendment filed on December 11, 2000.

Status of Claims

2. Of the original claims 1-46, claims 1-5, 17, 19, 23, 25-29, 39, 41, and 45 have been amended in the amendment filed on October 15, 1999. In the amendment filed on May 10, 2000, claims 1-3, 6-10, 12, 14-27, 30-34, 36-38, 40, 41, and 43-46 have been amended, and claims 47-51 have been added. Claims 1, 6, 23-25, 45-47, and 51 have been amended, and claims 52-57 have been added in the amendment filed on December 11, 2000. Therefore, claims 1-57 are under prosecution in this application.

Summary of Office Action

3. Applicants' arguments filed on December 11, 2000 have been fully considered, and discussed in the next section below or within the following rejections under 35 U.S.C. § 102 and § 103 are not deemed to be persuasive. Therefore, claims 1-57 are rejected as being unpatentable over the art cited below, and Applicant's request for allowance is respectfully denied.

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Response to Applicants' Amendment

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3, 7, 14-21, 23, 25-27, 31, 36-43, 45, and 47-50 are rejected under 35 U.S.C. 102(b) as being anticipated by Greer et al. European Pat. No. 0 511 463 A2 as discussed in paragraph 5, of paper number 13.

Further: Greer teaches the step of identifying discount triggering items in an initial purchase transaction at an initial vendor, the discount triggering items associated with a pre-determined redeemable item, each of the discount triggering items having a unique code associated therewith and an associated discount value, and --- the redemption value representing a discount available for use in a subsequent purchase transaction at a subsequent vendor, --- (col. 2, line 54 thru col. 3, line 55, and col. 5, lines 30-50, and col. 7, lines 1-37).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

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rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or unobviousness.

8. Claims 4-6, 8-13, 22, 24, 28-30, 32-35, 44, 46, and 51 are rejected under 35 U.S.C. 103(a) as discussed in paragraphs 8 and 9, of paper number 13.

9. Claims 52-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greer et al. European Pat. No. 0 511 463 A2.

Claims 52-57, Greer fails to teach that the subsequent vendor comprising a gas station and the initial vendor comprising a grocery store, and the pre-determined redeemable item comprising fuel.

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Official Notice is taken that issuing a coupon to a consumer at an initial vendor that is redeemable at a subsequent vendor distinct from the initial vendor is old and well known in the art. For example, in the air line industry, a consumer that flies so many miles is offered discount coupons for rental cars. The fact that the subsequent vendor comprising a gas station and the initial vendor comprising a grocery store, and the pre-determined redeemable item comprising fuel is just a field of use.

It would have been obvious to one of ordinary skilled in the art at the time the applicant's invention was made to modify the teachings of Greer to include that the subsequent vendor comprising a gas station and the initial vendor comprising a grocery store, and the pre-determined redeemable item comprising fuel, since both systems are concerned with benefiting consumers, vendors, and manufacturers by automatically rewarding the purchase of a variety of selected products, and to ensure purchase of the discounted product, see Greer (col. 2, lines 7-19).

Response to Arguments

10. Applicant's arguments filed December 11, 2000 have been fully considered but they are not persuasive.

In the remarks, the Applicant argues in substance that;

Greer reference fails to teach that the discount is applied to a pre-determined redeemable item, and that Greer teaches the discount may be applied to any customer order on subsequent visit. Greer fails to teach that all elements of claim 1, wherein a customer is given an incentive to

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purchase a discount triggering item from a initial vendor and to purchase the pre-determined redeemable item from a subsequent vendor.

In response to the above arguments;

The Examiner maintains the rejection of claims 1, 25, and 51, as currently amended, as being anticipated by Greer et al. reference, EP 0 511 463. Greer discloses the generating of a cumulative discount certificate for use in a later transaction, storing the terms of multiple product discounts that are subject to accumulation on a single discount certificate, and identifying triggering products in the customer order (col. 3, lines 4-55). Furthermore, in giving the claims their broadest reasonable interpretation, the Examiner is interpreting the phrase "an initial vendor, ---- and a subsequent vendor" as being the same vendor, since the claim fails to distinguish between both vendors. Using this interpretation, Greer discloses Applicant's newly added limitations of "identifying discount triggering items in an initial purchase transaction at an initial vendor, the discount triggering items associated with a pre-determined redeemable item, each of the discount triggering items having a unique code associated therewith and an associated discount value, and --- the redemption value representing a discount available for use in a subsequent purchase transaction at a subsequent vendor, --- (col. 2, line 54 thru col. 3, line 55, and col. 5, lines 30-50, and col. 7, lines 1-37). Greer reference clearly teaches the claimed limitations of the above argued claims. Thus, for the reasons mentioned above, the Examiner maintains his rejection of Claims 1, 25, and 51, as currently amended, under 102(b) as being

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anticipated by Greer et al.

With regard to the remaining claims, as Applicant's arguments are similar to those presented claims above, the Examiner refers Applicant to the above discussion.

Conclusion

11. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hani Kazimi whose telephone number is (703) 305-1061. The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065.

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The fax number for Formal or Official faxes and Draft or Informal faxes to Technology Center 2100 or this Art Unit is (703) 308-6296 or 6306.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Hani.Kazimi

February 22, 2001



VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100